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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,292	07/30/2001	Mitsuru Ohgake	R2184.0117/P117	8277
24998	7590	01/20/2006	EXAMINER	
DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP			AGUSTIN, PETER VINCENT	
2101 L Street, NW			ART UNIT	
Washington, DC 20037			PAPER NUMBER	
			2652	
DATE MAILED: 01/20/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/916,292		OHGAKE, MITSURU	
	Examiner		Art Unit	
	P. Agustin		2652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8-11 and 17-20 is/are allowed.
- 6) ☒ Claim(s) 1-7, 12-16 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

By

DETAILED ACTION

1. Claims 1-21 are now pending.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 27, 2005 has been entered.

Claim Objections

3. Claims 8-11 & 17-20 are objected to because of the following informalities:

Claims 8-11, the method steps labeled i, j, k, l & m need to be re-lettered as c, d, e, f & g, respectively.

Claims 17-20, the method steps labeled d, e, f, h, j, k, l, i & m need to be re-lettered as c, d, e, f, g, h, i, j & k, respectively.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 1-7, 12-16 & 21 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The

Art Unit: 2652

structural cooperative relationships between the claimed “first controller” (recited in claims 1, 12 & 21) and the other claimed elements have been omitted.

6. Claims 2-5 & 13-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

While base claims 1 & 12 provide antecedent basis for “strategy information”, there is insufficient antecedent basis for the limitations “said strategy information corresponding to device information of said recording and reading device and medium information of an optical recording medium” recited in claim 2 and “said strategy information corresponding to said device information and medium information” recited in claim 13. Applicant needs to positively recite these elements in order to further limit the claimed “strategy information”. Similarly, in regard to claims 5 & 16, while there is antecedent basis for “medium information”, there is insufficient antecedent basis for the limitation “said medium information additionally provided to said strategy information”.

Claims 2 & 13, last two lines recite “transmitting said strategy information with said medium information”. Claims 2 & 13 earlier define “strategy information” as corresponding to “device information” and “medium information”. Therefore, the recitation “transmitting said strategy information with said medium information” is inconsistent and renders the claims indefinite. Similarly, in regard to claims 5 & 16, the limitation “said medium information additionally provided to said strategy information” is inconsistent and renders the claims indefinite.

Claims 3-5 & 14-16 are dependent upon rejected base claims.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-7, 12-16 & 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakajo (US 5,502,702).

In regard to claim 1, Nakajo discloses a method for optically recording information in a system (Figure 1) comprising a recording and reading device (14, 16, 18, 22 & 26) that includes a first controller (26) and a strategy part (16 & 18) for conducting a strategy when optically recording information and an information processing apparatus (20 & 26) that includes a second controller (26) and a strategy information storing part (20) storing the strategy information for operating said strategy part (16 & 18), said method comprising the steps of: (a) reading said strategy information for operating said strategy part of said recording and reading device from said strategy information storing part of said information processing apparatus with said second controller (column 5, lines 37-45); and (b) transmitting said strategy information read in said step (a) to said recording and reading device (column 5, lines 37-45).

In regard to claim 2, Nakajo discloses the steps of: (c) storing said strategy information corresponding to device information of said recording and reading device and medium information of an optical recording medium to said strategy information storing part (column 5, lines 30-34; see also column 1, lines 17-28, which teach that recording power differs depending upon the type of dyestuff on a disc, and write strategy needs to be adjusted accordingly); (d)

Art Unit: 2652

transmitting the device information and the medium information from said recording and reading device to said information processing apparatus (column 5, lines 37-45); (e) reading said strategy information corresponding to said device information and medium information from said strategy information storing part in said information processing apparatus (column 5, lines 37-45); and (f) transmitting said strategy information with said medium information to said recording and reading device (column 5, lines 37-45).

In regard to claim 3, Nakajo discloses the steps of: (g) storing standard strategy information to said strategy information storing part (column 7, lines 26-35: "basic control information"); (h) reading said standard strategy information and transferring said standard strategy information to said recording and reading apparatus when the strategy information corresponding to the device information and the medium information transmitted from said recording and reading device is not stored in said strategy information storing part (column 7, lines 32-35).

In regard to claim 4, Nakajo discloses that said medium information is read and obtained from the optical recording medium (column 5, lines 35-45).

In regard to claim 5, Nakajo discloses that said step (h) cancels transmitting said device information and said medium information to said information processing apparatus when said medium information additionally provided to said strategy information stored in said strategy part corresponds to said medium information of said optical recording medium, and activates said strategy part to record to the optical recording medium (understood from column 7, lines 26-35).

In regard to claim 6, Nakajo discloses that a plurality of data sets of the strategy information is stored in said strategy part (column 5, lines 43-45).

In regard to claim 7, Nakajo discloses that said step (b) is conducted just before starting recording information to said optical recording medium (column 5, lines 40-42).

In regard to claim 12, Nakajo discloses a computer-readable recording medium (Figure 1, element 10) recorded with program code for causing a computer (B & C) to optically record information in a system comprising a recording and reading device (14, 16, 18, 22 & 26) that includes a first controller (26) and a strategy part (16 & 18) for conducting a strategy when optically recording information and an information processing apparatus (20 & 26) that includes a second controller (26) and a strategy information storing part (20) storing the strategy information for operating said strategy part (16 & 18), said program comprising the codes for: (a) reading said strategy information for operating said strategy part of said recording and reading device from said strategy information storing part of said information processing apparatus with said second controller (column 5, lines 37-45); and (b) transmitting said strategy information read by said code (a) to said recording and reading device (column 5, lines 37-45).

Claims 13-16 have limitations similar to those of claims 2-5; thus, they are rejected on the same basis.

In regard to claim 21, Nakajo discloses a method for optically recording information in a system (Figure 1) comprising (1) a recording and reading device (14, 16, 18, 22 & 26) that includes a first controller (26) and a strategy part (16 & 18) for storing and conducting a strategy when optically recording information and (2) an information processing apparatus (20 & 26) that includes a second controller (26) and a strategy information storing part (20) storing the strategy

Art Unit: 2652

information for operating said strategy part (16 & 18), said method comprising the steps of: (a) reading said strategy information for operating said strategy part of said recording and reading device from said strategy information storing part of said information processing apparatus with said second controller (column 5, lines 37-45); and (b) transmitting said strategy information read in said step (a) to said recording and reading device and storing said strategy information in said strategy part (column 5, lines 37-45).

Allowable Subject Matter

9. Claims 8-11 & 17-20 are allowed over the prior art of record.

Response to Arguments

10. Applicant's arguments with respect to claims 1-7, 12-16 & 21 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. Agustin whose telephone number is 571-272-7567. The examiner can normally be reached on Monday-Friday 9:30-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, A. L. Wellington can be reached on 571-272-4483. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2652

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

P. Agustin
Art Unit 2652



BRIAN E. MILLER
PRIMARY EXAMINER